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ALEXANDER L. STEVAS.

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In The

Supreme Court of the United States

October Term, 1983

KIMBERLY-CLARK CORPORATION,

Petitioner,

vs.

PETER GABOR KALMAN,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL
CIRCUIT**

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QUESTION PRESENTED FOR REVIEW

Whether the Court of Appeals for the Federal Circuit, now the sole court of appeals in patent infringement actions, correctly followed the holding of this Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) by now mandating that a determination of unobviousness under 35 U.S.C. §103 must include, as a primary factor, an evaluation of what this Court has termed "secondary considerations" or "subtests" of unobviousness, even where the claimed invention resides in a combination of steps or elements which are otherwise admittedly obvious in view of the prior art.

PARTIES BELOW

Plaintiff-respondent in this case is Peter Gabor Kalman.
Defendant-petitioner is Kimberly-Clark Corporation.

Pursuant to Rule 28.1 of this Court, petitioner Kimberly-Clark Corporation states that it has no parent companies, and that it has the following subsidiaries and affiliates (other than wholly owned subsidiaries):

Kimberly-Clark Corporation owns a majority interest in Neenah and Menasha Water Power Company and owns an interest in the following foreign affiliates: Kimberly-Clark de Centro America, S.A.; Kimberly-Clark Far East Pte. Limited; Kimberly-Clark International, S.A.; Kimberly-Clark Philippines, Inc.; Kimberly-Clark Thailand Limited; L.T.R. Industries, S.A.; Spruce Falls Power and Paper Company, Limited; YuHan-Kimberly, Limited; Carlton Paper Corporation Limited; Colombiana Kimberly S.A.; Colombiana Universal de Papeles S.A.; Jujo Kimberly K.K.; K.C.S.A. Holdings (Proprietary) Limited; Kimberly-Clark Australia Pty. Limited; Kimberly-Clark Malaysia; Kimberly-Clark de Mexico S.A. de C.V.; and Suzano Kimberly Industria e Comercio Ltda.

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Petitioner, Kimberly-Clark Corporation, respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in this proceeding on July 19, 1983.

OPINIONS BELOW

The District Court opinion is reported at 561 F. Supp. 628 (E.D. Wis. 1982) and appears at A28 in the Appendix.¹ A prior opinion of the District Court is reported at 215 USPQ 158 (E.D. Wis. 1981) and appears at A46. The Court of Appeals opinion is reported at 713 F.2d 760 (Fed. Cir. 1983) and appears at A1. The Judgment of the Court of Appeals appears at A56 and the Order of the Court of Appeals denying rehearing and rehearing en banc appears at A57.

JURISDICTION

The Judgment of the Court of Appeals for the Federal Circuit was entered on July 19, 1983. A timely petition for rehearing and rehearing en banc was denied on September 20, 1983, and this petition for certiorari is being filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. §1254(1).

STATUTE INVOLVED

35 U.S.C. §103:

"Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

1. The abbreviation "A" herein and throughout this petition refers to the Appendix submitted separately herewith, the number following is the page of the Appendix.

prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

STATEMENT OF THE CASE

A. The Nature Of The Case And The Disposition Below

This is a patent infringement case initiated by respondent, Peter Gabor Kalman ("Kalman"), against petitioner, Kimberly-Clark Corporation ("K-C"). Kalman's complaint charged K-C with infringement of certain claims of his U.S. Patent No. 3,471,017 (hereinafter "the Kalman patent"). Jurisdiction of the District Court was invoked under 28 U.S.C. §1338(a).

After a bench trial, the District Court issued a Decision and Order (A28) finding that all of the asserted claims of the Kalman patent were valid and had been infringed by K-C. The Court of Appeals for the Federal Circuit ("CAFC") affirmed.²

B. Facts Relevant To The Issues Presented For Review

1. *The Technology Involved*

The Kalman patent (A59) relates to a process and apparatus

2. The sole ground for affirmance challenged here was the CAFC's reliance on evidence of such secondary considerations as commercial success and long-felt need, in the face of testimonial admission of obviousness, to find the invention unobvious and the patent valid in direct contradiction of this Court's mandate in *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

for filtering a heat-softened substance, such as a thermoplastic.³ In processing such plastic material the plastic is heated to a flowable state in an extruder which forces the softened plastic under pressure through a restricted opening or die where it may be molded into a usable shape or formed into a film. Sometimes it is desirable to interpose some type of filtering device in the stream of heated plastic to remove undesired contaminants. These filters typically include some type of mesh screen through which the molten plastic is forced so that the screen catches and traps contaminants. The Kalman patent discloses such a method and apparatus for filtering thermoplastic material without requiring an interruption in the extrusion process.

2. The Kalman Patent Disclosure

According to the Kalman patent, his invention is said to be a filtering device having a main passage through which the heated plastic material is forced to flow. A filter screen in the form of a band or ribbon extends across the plastic flow passage. The screen also passes through transverse slotted inlet and outlet ports on each side of, and flanking, the main flow passage. The device includes heaters to keep the plastic at an elevated temperature (to melt or soften the plastic to a flowable state) but the temperature at the outer portions of the filter inlet and outlet ports is kept at a lower and cooler temperature so that the plastic in these ports becomes more rigid. This rigid plastic within the inlet and outlet ports, in essence a solidified plastic plug, acts as self-replacing sealing plugs at the entry and exit points for the filter ribbon.

During a filtering operation the heaters maintain the plastic in the flow or main passage at high enough temperature so that

3. A "thermoplastic" is simply a material which becomes soft and flowable on heating and solid when cooled.

the plastic material is in a soft and flowable state. However, the inlet and outlet ports on each side of the main flow passage are kept at about room temperature by flowing suitable coolant (such as water) through channels next to these side ports. Because of this cooling effect solid plugs of the plastic are formed near the ends of the inlet and outlet side ports. These plastic plugs seal in the filter screen at both sides and prevent its movement.

When a filter change is necessary, usually because contaminants, such as bits of dirt, have clogged the screen, the filter ribbon is moved through the filtering enclosure in steps by periodically shutting off the cooling water and raising the temperature of the sealing plugs in the ports. As the outer surface of the substantially solid plastic plugs within the inlet and outlet side ports gradually soften, the filter ribbon becomes free to move. When the filter band moves, a clean portion of the filter screen is placed across the flow passage. After the clean filter screen is in place in the main flow passage, heating of the inlet and outlet ports is discontinued and the cooling water supply is reestablished to solidify the plugs within the inlet and outlet side ports and stop further movement of the filter ribbon.

3. The Prior Art Relied On To Show That The Claimed Invention Was Obvious

a. The Moziek Patent

The principal prior art reference relied upon is the Moziek patent⁴ (A65). The Moziek patent, just like the Kalman patent, relates to an apparatus for extruding and filtering thermoplastic material.

Moziek discloses a heated extruder to force softened plastic into a filter device which includes a main flow passage (just like

4. U.S. Patent No. 3,112,525 issued December 3, 1963.

the flow passage in the Kalman patent) through which the softened plastic material is forced to flow. The Moziek device shows use of a slidable filter cartridge assembly positioned in a transverse slot across the plastic flow passage. This slot is in the same orientation as the slot for the filter band in the Kalman patent. The Moziek device, just like the Kalman patent, also includes side inlet and outlet ports at each end of the transverse slot. In Moziek the filter screen element is in a cartridge assembly which includes a framed perforated holder, a mesh filter screen and a screen retainer (Fig. IV, A68).

The Moziek patent shows rotatable valves (Fig. III, A67) at each end of the transverse slot at what are the ends of the inlet and outlet ports. In one position the valves seal off the ends of the slot and when the valves are rotated to a second position the slot is completely open to allow insertion of a new filter screen cartridge assembly in one side and removal of the clogged one from the other side.

According to the Moziek patent, the rotating valves at each end are kept closed with a cartridge filter screen assembly in place. As plastic material is forced through the filter screen, the screen eventually becomes clogged with contaminants and must be replaced. The screen replacement is done without interrupting continuous extrusion operations by opening up the valves at each end and slowly pushing a new filter cartridge in and pushing the dirty cartridge out.

When it is desired to effect a screen change, the Moziek patent specifies (A72, Col. 5, 11. 66-75 to Col. 6, 11. 1-9) that:

“While thermoplastic material is being extruded, the valve means 36a and 36b are opened by turning the valve cores 50a and 50b 90° clockwise and counter-clockwise respectively. A fresh cartridge

assembly (not shown) of the same construction as the illustrated assembly 32 is then positioned within one end of the slot 34 and brought into abutting contact with one end of the clogged slidable cartridge assembly 32. Force is then applied to the fresh assembly by any suitable means (not shown), such as a retractable ram, rod or similar device in order to progressively push the fresh assembly into the slot 34 and force the clogged assembly 32 beyond the chamber 26 where it can be readily pulled out the other end of the slot 34 by manual or automatic means. It is preferable that the replacement operation be performed at a rate such that each increment of the fresh assembly is heated by the temperature of the thermoplastic material within the chamber 26 before being forced therein."

The Moziek patent also discloses a construction for the rotatable valves to provide additional cooling and this is explained as follows (A71, Col. 3, 11. 73-75 to Col. 4, 11. 1-12):

"The tendency of most thermoplastic materials to leak past the valve means is generally dependent on the fluid viscosity of the thermoplastic material at the temperature of extrusion. For materials of low fluid viscosity, it has been found that *leakage can be further reduced by supplemental cooling of the valves*. This may be most conveniently done by hollowing or jacketing portions of the valve means to permit *circulation of a cooling medium*. One embodiment for supplementally cooling of valve means 36a and 36b is shown in Fig. IV wherein a valve core has been hollowed out and equipped with intake and discharge nozzles 63a

and 63b respectively for the circulation of a cooling medium. If supplemental cooling is desired, this alternate valve core could be substituted for the valve core 50a shown in Fig. III." (emphasis added).

Thus Moziek teaches that cooling of the valves can be done to cool the plastic. This cooling, of course, will solidify the plastic in the inlet and outlet ports to further reduce leakage, especially when both ports are completely open during a filter screen change.⁵

b. The Garrahan Patent

The Garrahan patent⁶ (A74) relates to a device for straining scrap rubber and like materials (all thermoplastic materials) to remove contaminants. To do this the Garrahan patent discloses a straining head for attachment to the end of an extruder. The strainer is provided with a main flow passage (like the one in the Kalman patent) through which the softened material is forced to flow. The strainer discharges in three directions but at *each* discharge outlet guideways are formed to accommodate a long filter which extends beyond the confines of the strainer head and transverse to the flow path. In essence this long strainer passes through side inlet and outlet ports in the same orientation as the Kalman invention.

In operation, when the filter becomes clogged with contaminants, the filter is moved until a fresh part of the filter is in registry with the main flow path allowing the clogged filter part to extend outside of the apparatus, so it can be cleaned. All

5. The Moziek patent (A71, Col. 3, ll. 64-68) states: "The purpose of the valve means 36a and 36b is to prevent excessive leakage during extrusion of thermoplastic material, *particularly on screen changes* [when both valves are open] and to eliminate partial disassembly of the unit before a screen change could be made." (emphasis added).

6. U.S. Patent No. 1,195,576 issued August 22, 1916.

of this is done while the extruder remains in operation so that there is no interruption in the extrusion process while a clean part of the filter is moved into the flow path.

4. The Device Found To Infringe

Like the Kalman and Moziek devices, the accused device has a main flow passage for heated and softened plastic material to flow. A transverse slot is provided and each end of the slot, on either side of the flow passage, is cooled by forced air to solidify the plastic in the slots. Instead of the filter band or ribbon of the Kalman patent, the accused device uses a variation of the Moziek slidable filter cartridge assembly in that a series of separate but mechanically interlocked heavy metal filter cartridge assemblies are used. A hydraulic ram pushes the interconnected filter plates through and when a complete plate emerges from the exit slot it is unhooked and removed for cleaning. A fresh clean plate is then hooked on to the assembly at the inlet side (see for example the representation at A6). Like the Moziek device the major portion of the inlet and outlet ports or slots is filled by the mass of metal comprising the filter assembly. In fact the clearance between the slot and the filter assembly is but .003 to .005 inches.

5. The Obviousness Argument Advanced Below

In both the District Court and the CAFC, K-C maintained that the *claimed* Kalman invention at issue was obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. §103 in view of the teachings of the Moziek patent (A65) and the Garrahan patent (A74).⁷

7. K-C also argued that if the Kalman claims were read broadly enough to read on the accused device, then the scope of the claims for purposes of determining validity should be equally as broad. This is true because a claim is not a "nose of wax" to be twisted one way to determine validity and another way to catch infringement. See *White v. Dunbar*, 119 U.S. 47 (1886).

K-C urged in both courts below that the mandate of *Graham v. John Deere Co.*, 383 U.S. 1 (1966) should be followed. In *Graham*, this Court instructed that (1) the scope and content of the prior art should be determined, (2) the differences between the prior art and the claims at issue should be ascertained, and (3) the level of ordinary skill in the art resolved. Against this background, the obviousness or unobviousness of the claimed subject matter is determined.

Adhering to *Graham*, K-C analyzed each element of the *claimed* invention at issue for both courts and compared these elements to the prior art. The following columnar presentation compares the only two independent Kalman patent claims with the scope and content of the prior art.

Claim 1 — The Process Claim

Claimed Recitation

A process for filtering a heat-softened substance flowing through a passage comprising

the steps of introducing a filter band or ribbon

Scope and Content of the Prior Art

The Moziek patent (A65) discloses a process for filtering a heat-softened substance flowing through a passage, chamber 26.

Moziek discloses a filter, the assembly of a perforated holder 64, screen 66 and screen retainer 68 (Fig. V, A68) Kalman's expert witness conceded that the Moziek filter is a band under the dictionary definition of band (A93).

by passing it through inlet and outlet ports flanking said passage so that a part of the filter extends across said passage,

forcing the substance through the filter part to filter said substance

whilst providing temperature conditions at said inlet and outlet ports resulting in the formation within said ports of sealing plugs of said substance of adequate rigidity to prevent substantial leakage at said ports,

and, when desired, effecting movement of said filter through said ports under conditions providing for self-maintenance of said sealing plugs to introduce another part of said filter band or ribbon into said passage.

The Moziek device in a screen change mode with both valves open define inlet and outlet ports flanking the passage through which the heat-softened substance flows (A82-83, A90).

Moziek forces the thermoplastic material through his filter assembly because of the extruder screw 14 (A72, col. 5, 11. 46-49).

Moziek's alternative valve form (A67, Fig. 4) having provision to circulate a cooling medium through the valves is described as being to reduce leakage (*supra*, pp. 7-8) Kalman's experts conceded sealing plugs would be formed by this Moziek construction (A84-85, A88-89) and K-C's expert also agreed (A95-96).

Moziek in the screen change mode responds to this recitation when the alternative cooled valve cores are used. Kalman's expert witness conceded Moziek teaches continued circulation of the cooling medium (A88).

Claim 18 — The Apparatus Claim

Claimed Recitation

A filter device for filtering a heat-softened substance,

including a body defining a passage through which said substance can be caused to flow

and slotted inlet and outlet ports flanking said passage

through which a filter in the form of a band or ribbon is passed and can be moved to introduce different parts of said filter across said passage

said ports being adapted for the formation therein, in use, of sealing plugs of the substance being filtered permitting movement of said filter through said slots without substantial leakage of said substance

Scope and Content of The Prior Art

The Moziek patent discloses a device for filtering a thermoplastic material which is by definition a heat-softened substance.

Moziek shows a casing 24 defining a chamber 26 through which the heat-softened substance is caused to flow (A90-91, A99-100).

Moziek with valves 36a and 36b open for a screen change discloses this element (A90-91, A99-100).

Moziek in a screen change mode with both valves open responds to this claim element, Moziek patent A65, *supra*, pp. 6-7. (A90-91, A99-100).

Moziek responds fully to this recitation with the cooled valve cores (*see quote supra*, pp. 7-8 A86-87, A99-100).

and means to provide temperature conditions at said ports to form said plugs.

Moziek's cooled valve corresponds fully to this recitation (A86-87, A91-92, A99-100).

The CAFC affirmed the District Court's judgment that the Moziek patent did not fully anticipate the claimed invention. The CAFC, while noting the District Court incorrectly analyzed the law of anticipation (A21), nevertheless held that one element of the *claimed* invention was not disclosed in Moziek and this was enough to prevent the patent claims from being held invalid as fully anticipated under 35 U.S.C. §102.⁸ The one claim element the CAFC found lacking was that "Moziek makes no provision for a band or ribbon or any length of filter." (A21).

Kalman's expert at trial conceded that under the definition of band he established in the case, the Garrahan patent showed a filter in the form of a band (A94). This is the only element the CAFC found missing from the Moziek patent. Furthermore, as noted in the CAFC decision (A26), Kalman's expert also acknowledged it would be obvious to combine the teaching of the Garrahan patent with the Moziek device. That testimony was as follows:

"Q. So, if I saw the device I had constructed
[a Moziek-type device] worked without leaking and

8. K-C urged below that the Moziek patent was a full anticipation of the *claimed* Kalman invention at issue under 35 U.S.C. §102. The only element lacking from the claimed invention was that in Moziek the *same* filter was not in both the inlet port and the outlet port at the same time. This is true because Moziek discloses the use of two cartridge filter assemblies, in the form of a band, the fresh one entering the inlet, butting against the clogged filter in the device and slowly pushing the clogged filter out the outlet port. K-C had argued that the *claimed* Kalman invention did not require that the same filter band be in both ports at the same time.

I saw Garrahan, could I say why can't I use Mr. Garrahan's teaching with a device that Mr. Moziek taught me to build, because I know it would work? A. What is Mr. Garrahan's teaching that you're postulating?

Q. Use of a long filter band that extends out — out of my extruder pad or my screen changer body. A. All right.

Q. Would that be a fair combination of the teachings of Garrahan and Moziek? A. Well, yes, I'd say so. This is a slide changer, and that's a slide changer. Why not use this instead of that."

While apparently acknowledging this admission, the CAFC determined that it was not an adequate basis for a finding of obviousness and patent invalidity (A26). The CAFC relied instead on "other evidence respecting the nonobviousness of Kalman's claimed invention" (A27) — the secondary considerations — and found that these considerations tipped the scale to hold the claimed subject matter unobvious and, hence, the patent valid.¹⁰

9. This admission also establishes the level of ordinary skill in this art along with the teachings of the Moziek and Garrahan patents as well as other patents cited which showed recognition in the plastic working field that chilling hot plastic results in a solidification of the plastic and that such solidified plastic could be used as a seal against leakage.

10. The reliance in both courts below on the secondary consideration evidence is somewhat anomalous in view of the District Court's statement, after an objection by K-C's counsel, that "Well commercial success is — this case is *not* going to be decided on the issue of commercial success, but it's just one of the more or less *minor* factors that I can consider." (emphasis added, Tr. 214).

The CAFC also termed K-C's proposed combination of references a hypothetical combination of prior art features.¹¹ However, this criticism rings hollow because Kalman's expert admitted that the combination of the Moziek and Garrahan patent teachings was "fair." Thus, in reality, the CAFC was swayed by the secondary consideration evidence of commercial success and long-felt need and promoted these secondary objective considerations to a level of sufficient importance to enable the CAFC to override the clear testimonial admission of obviousness.

REASONS FOR GRANTING THE WRIT

I.

The CAFC's reliance on secondary considerations to salvage an otherwise obvious invention is contrary to clear holdings of this Court.

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), this Court for the first time had an opportunity to interpret newly enacted Section 103 of the Patent Act of 1952. In *Graham* this Court found that Section 103 was merely a codification of the standard of invention enunciated in *Hotchkiss v. Greenwood*, 11 How. 248 (1850) and not a change in the law:

"We believe that this legislative history, as well as other sources, shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the

11. This is a mischaracterization of K-C's position below. K-C had advanced only two arguments of invalidity, one being the claims were anticipated under 35 U.S.C. §102 by Moziek alone or obvious, under 35 U.S.C. §103, in view of Moziek and Garrahan alone. The other prior art discussed by K-C was cited only to show the state of the art to determine the level of ordinary skill in the art.

section [103] was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability." 383 U.S. at 17.

The *Graham* Court then went further and noted that such secondary considerations as commercial success, etc. "may have relevancy." In light of this Court's determination that Congress had not intended to change the general level of patentable invention, it is apparent that earlier decisions of this Court may be looked to for a determination of the circumstances under which these "secondary considerations" are relevant.

Prior to *Graham*, this Court consistently held that secondary considerations without invention will not make a patentable invention. *Deforest Radio Co. v. General Electric Co.*, 283 U.S. 664, 685 (1931); *Textile Machine Works v. Louis Hirsch Textile Machines*, 302 U.S. 490, 498-99 (1934); *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U.S. 464, 473-77 (1935); *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 487-88 (1935); *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, 356-57 (1939); *Dow Chemical Co. v. Halliburton Oil Well Cementing Co.*, 324 U.S. 320, 330 (1945); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 153 (1950).

Since *Graham* this Court has unswervingly reiterated that principle and rejected any assertion that the standard of patentable invention can be established solely by the objective criteria of the secondary considerations. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U.S. 57, 61 (1969); *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282-83 (1976); *Dann v. Johnston*, 425 U.S. 219, 230, fn. 4 (1976). See also, dissent of Justices White

and Brennan from denial of certiorari in *Roanwell Corp. v. Plantronics, Inc.*, 429 U.S. 1004 (1977).

Despite the clear holdings of this Court that "secondary considerations" cannot make an otherwise obvious invention patentable, the CAFC, now the single court of appeals in patent cases, has enunciated a new standard at variance with the standard set out by this Court.

The case at bar is not an isolated incident as the following recent cases from the CAFC show:

"The district court erred in saying: 'Where a *patent* is obvious, it cannot be saved from invalidity by resorting to "secondary factors" . . .' The issue is the obviousness of the *claimed invention*, and that issue can be resolved only after *all* relevant evidence of obviousness, including so-called 'secondary considerations' if any, has been taken into account."

Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1580 (Fed. Cir. 1983).

"As is or should be true with every performance of the judicial process, all relevant evidence on each dispositive issue [*i.e.*, secondary considerations] must be fully considered and evaluated."

Environmental Designs, Ltd. v. Union Oil Co. of California, 713 F.2d 693, 695 (Fed. Cir. 1983).

"It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included. Thus evidence arising out

of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness. . . . It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art."

Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (Fed. Cir. 1983).

"In evaluating the commercial success evidence, Judge Kelleher said, 'commercial success without invention will not make patentability.' That approach was flawed, as explained in *Stratoflex, supra*" [reference is to *Stratoflex, Inc. v. Aeroquip Corp.*, 714 F.2d 1530, 1538 (Fed. Cir. 1983)].

Kansas Jack, Inc. v. Kuhn, ____ F.2d ____, 219 USPQ 857, 861 (Fed. Cir. 1983).

Yet what Judge Kelleher said in the quote above, which the CAFC said was flawed, is what this Court said in *A&P, supra*, 340 U.S. at 153.

The CAFC in *South Corporation v. United States*, 690 F.2d 1368 (Fed. Cir. 1982) has stated that it will be bound by the decisions of its two predecessor courts, the Court of Customs and Patent Appeals and the Court of Claims. Thus, the *South* precedent incorporates prior decisions of the CCPA requiring evaluation of evidence on the secondary considerations in *all* cases, not just when the issue of obviousness remains in doubt after application of the three pronged *Graham* factual analysis. See *Stevenson v. ITC*, 612 F.2d 546, 553 (CCPA 1979); *Solder*

Removal v. ITC, 582 F.2d 628, 635 (CCPA 1978); *In re Fielder*, 471 F.2d 640, 644 (CCPA 1973).¹²

II.

The regional courts of appeals had uniformly properly followed the decisions of this Court.

Prior to October, 1982 when patent appeals were heard by the regional courts of appeals, they had universally followed the direction of *A&P* and *Black-Rock* that evidence of "secondary considerations" was to be looked to only in cases where the question of obviousness, after application of the *Graham* factual inquiry, remained in doubt.

Merely illustrative of those appellate courts' views are the following relatively recent cases: *International Tel. & Tel. Corp. v. Raychem Corp.*, 538 F.2d 453, 459 (1st Cir.), cert. denied, 429 U.S. 886 (1976); *Timely Products Corp. v. Arron*, 523 F.2d 288, 295 (2d Cir. 1975); *Digitronics Corp. v. New York Racing Association, Inc.*, 553 F.2d 740, 748-49 (2d Cir.), cert. denied, sub. nom., *Amperex Electronics Corp. v. New York Racing Association, Inc.*, 434 U.S. 860 (1977); *Systematic Tool & Machine*

12. While *South Corporation v. United States*, 690 F.2d 1368 (Fed. Cir. 1982) indicated precedents of the Court of Claims would be binding as well, the CAFC is apparently ignoring, without expressly overruling, contrary holdings on this point by its predecessor Court of Claims. See *Kemode Mfg. Co. v. United States*, 347 F.2d 315, 319 (Ct. Cl. 1965) where the Court held:

"[I]t is only in those cases where the question of patentable invention is in doubt that evidence of commercial success can be persuasive of patentability."

Accord, Karch v. United States, 568 F.2d 722, 728 fn. 6 (Ct. Cl. 1977), cert. denied, 436 U.S. 956 (1978).

Co. v. Walter Kidde & Co., Inc., 555 F.2d 342, 343 fn. 2 (3rd Cir.), *cert. denied*, 434 U.S. 857 (1977); *Reed Tool Co. v. Dresser Industries, Inc.*, 672 F.2d 523, 527 fn. 11 (5th Cir. 1982); *Cathodic Protection Service v. American Smelting Refining Co.*, 594 F.2d 499, 513 (5th Cir.), *cert. denied*, 444 U.S. 965 (1979); *Parker v. Motorola, Inc.*, 524 F.2d 518, 531 fn. 13 (5th Cir. 1975), *cert. denied*, 425 U.S. 975 (1976); *May v. American Southwest Waterbed Distributors, Inc.*, 715 F.2d 876, 884-85 (5th Cir. 1983); *Philips Industries, Inc. v. State Stone & Mfg. Co., Inc.*, 522 F.2d 1137, 1141-42 (6th Cir. 1975); *American Seating Co. v. National Seating Co.*, 586 F.2d 611, 622 (6th Cir.), *cert. denied*, 441 U.S. 907 (1978); *Eltra Corp. v. Basic, Inc.*, 599 F.2d 745, 756 (6th Cir.), *cert. denied*, 444 U.S. 942 (1979); *Panduit Corporation v. Burndy Corporation*, 517 F.2d 535, 541 (7th Cir.), *cert. denied*, 423 U.S. 987 (1975); *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 975-76 (7th Cir. 1979); *Lee Blacksmith, Inc. v. Lindsay Bros., Inc.*, 605 F.2d 341, 345 (7th Cir. 1979); *Ashland Oil, Inc. v. Delta Oil Products Corp.*, 685 F.2d 175, 177-78 (7th Cir. 1982), *cert. denied*, ____ U.S. ____, 103 S. Ct. 1769 (1983); *Brunswick Corp. v. Champion Spark Plug Co.*, 689 F.2d 740, 751-52 (7th Cir. 1982); *Exer-Genie, Inc. v. McDonald*, 453 F.2d 132, 136 (9th Cir. 1971), *cert. denied*, 405 U.S. 1075 (1972); *Deere & Co. v. Sperry Rand Corporation*, 513 F.2d 1131, 1133 (9th Cir.), *cert. denied*, 423 U.S. 914 (1975); *Bristol Locknut Co. v. SPS Technologies, Inc.*, 677 F.2d 1277, 1281 (9th Cir. 1982); *Deere & Co. v. Hesston Corp.*, 593 F.2d 956, 962 (10th Cir.), *cert. denied*, 444 U.S. 838 (1979).

Indeed the Second Circuit, after straying from application of this principle in *Plantronics, Inc. v. Roanwell Corp.*, 403 F. Supp. 138, *aff'd per curiam*, 535 F.2d 1397 (2d Cir. 1976), *cert.*

denied, 429 U.S. 1004 (1977), came back into the fold in *Digitronics, supra*.¹³

Thus, it is evident that prior to the advent of the CAFC, the regional courts of appeals had uniformly and correctly applied the *standard* for determining obviousness of an invention as that *standard* has been interpreted by this Court.

III.

The Need For Review By This Court

Since its creation by the Federal Courts Improvement Act of 1982, §402, 28 U.S.C. §171, the CAFC is now the only court of appeals to review judgments of all the district courts rendered in actions for patent infringement, 28 U.S.C. §1295(a)(1). The district courts now look to the CAFC for instruction and guidance in interpreting the patent law.¹⁴ With the CAFC's adoption of

13. There, 553 F.2d at 748, the Court commented:

"Any theory that 'secondary' considerations must be given weight before a determination of obviousness can be made was laid to rest in *Sakraida v. Ag Pro, Inc.*,"

* * *

"Only in a close case, in which application of the subjective criteria of nonobviousness in 35 U.S.C. §103 does not produce a firm conclusion can these objective or secondary considerations be used to 'tip the scales in favor of patentability'. *Roanwell Corp. v. Plantronics, Inc.*, *supra*, 429 U.S. at 1008, 97 S. Ct. at 541 (White, J. joined by Brennan, J. dissenting from denial of certiorari) . . ."

14. See *Air Products and Chemicals, Inc. v. Chas. S. Tanner Co.*, ____ F. Supp. ____, 219 USPQ 223, 227 (D.S.C. 1983) where the Court stated:

(Cont'd)

the prior precedents of the CCPA, decisions such as *In re Fielder*, 471 F.2d 640 (CCPA 1973), cited by the CAFC as authority in *Stratoflex, supra*, are now binding on the district courts. *Fielder* was written after this Court's decision in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) where this Court reiterated:

"It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But those matters 'without invention will not make patentability.' *A&P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 153." 396 U.S. at 61.

While acknowledging *Black-Rock*, the *Fielder* court stated that it was error to fail to consider evidence of commercial success and satisfaction of long-felt needs. In *Fielder* there even was a concession of *prima facie* obviousness, 471 F.2d at 642, but the *Fielder* court took pains to make clear that it was error to disregard such evidence of secondary considerations even in the face of a concession of obviousness.

It is now clear that the new CAFC has departed radically from this Court's clear mandate regarding the proper place of

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"As of October 1, 1982, the United States Court of Customs and Patent Appeals ("CCPA") and the United States Court of Claims were merged to form the United States Court of Appeals for the Federal Circuit ("CAFC"). The new court has exclusive appellate jurisdiction of appeals in all patent infringement actions. 28 U.S.C. §1295(a)(1). In a recent decision, *South Corp. v. United States*, 690 F.2d 1368, 1369, 215 USPQ 657 (Fed. Cir. 1982), the new court ruled that all decisions of its predecessor courts will be considered binding as precedents upon it. Those decisions are therefore controlling here."

"secondary considerations" in a long line of decisions, *e.g.*, *A&P*, *Graham*, *Sakraida*, *Black-Rock*, *supra*. The CAFC's *de facto* repudiation of *Black-Rock* and *A&P* as the definitive guidelines for handling evidence of the "secondary considerations" is manifest. Instead of following the three step factual inquiry set down in *Graham*, which clearly implies that evidence of "secondary considerations" is subordinate and is to be turned to only in cases of doubt as to obviousness, the CAFC instead has unjustifiably elevated commercial success and the other objective secondary considerations to be the bell-weather barometer of patentable invention.

As recognized by this Court in *Graham*, *supra*,

"[T]he federal patent power stems from a specific constitutional provision which authorizes the Congress 'To promote the Progress of *** useful Arts, by securing for limited Times to *** Inventors the exclusive Right to their *** Discoveries.' Art. I, §8, cl. 8. The clause is both a grant of power and a limitation. . . . The Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of *** useful Arts.' This is the *standard* expressed in the Constitution and it may not be ignored. And it is in this light that patent validity 'requires reference to a standard written into the

Constitution.' Great A&P Tea Co. v. Supermarket Equipment Corp. . . . 340 U.S. at 154 (concurring opinion)." 383 U.S. at 5-6.

If Congress is constrained to be guided by the constitutional standard, should not all courts and especially the court charged with the sole appellate responsibility for decisions of patent validity be constrained to follow the same standard? To pose the question is to answer it.

The mere fact that one reaps commercial success from marketing an invention should not become part of the standard of patentability in *all* cases. The fact that an invention satisfies a long-felt need is no indication, standing alone, that the invention itself is not obvious. An inventor is charged with the knowledge of all the accumulated publicly available prior art at the time the invention is made.¹⁵ That is the basis for this Court's statement in *Graham*, that "Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain." 383 U.S. at 6.

15. As effectively stated by Judge Learned Hand in *Frank B. Killian & Co. v. Latex Corp.*, 188 F.2d 940, 943 (2d Cir.), *cert. denied*, 342 U.S. 861 (1951):

"Moreover, presumably he [the inventor] designed his machine from the ground up and without suggestion or cue; and we may well agree that, taken as a feat, that displayed enough originality to support a patent. However, as we have just said . . . , the law does not use such a subjective test in judging a patent; on the contrary it imputes to the inventor an omniscience which will again and again deprive him of the reward that his talents as an individual might otherwise deserve. That is a corollary of a monopoly, not limited to plagiarists."

See also, *Seewall v. Jones*, 91 U.S. 171 (1875).

That no one person has all of the accumulated knowledge of all the prior art (which knowledge, however, is imputed to a patentee) and that a long-felt need for an invention may, therefore, exist is irrelevant. If the invention only combines old elements in a manner clearly embraced by the prior art, it fails to meet the constitutional standard for patentability. Those factors serve only to confirm the wisdom of this Court's admonition that evidence of the so-called secondary considerations should not tip the scales to make patentable that which is no more than an obvious invention.

This clear departure by the CAFC in deciding the important federal question of obviousness of a patented invention is in conflict with every applicable decision of this Court. Clearly, this Court should exercise its discretion under Rule 17, Supreme Court Rules, and issue a writ of certiorari.

Absent positive and effective direction by this Court, it is apparent that the CAFC will continue to set aside this Court's clear prior mandates. The result will be the imposition on the district courts of a more lenient standard of patentability. The erosion of that standard will eventually constrain the free and unfettered use by the public of technology within the public domain. It is imperative that this Court act at the earliest opportunity to give proper direction to the appellate court solely responsible for overseeing the patent system.

CONCLUSION

For all the reasons stated, it is respectfully requested that this Court grant the petition for writ of certiorari to the Court of Appeals for the Federal Circuit to review the decision below.

Respectfully submitted,

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